

REMARKS/ARGUMENTS

Applicants have received the Office action dated September 8, 2004, (hereinafter the "Office Action") in which the Examiner: 1) rejected claims 1-3, 5, 6, 8-10, 12 and 13 under 35 U.S.C. § 102(b) as allegedly anticipated by *Narita et al.* (U.S. Pat. No. 5,465,039, hereinafter "Narita"); 2) rejected claims 4, 7, 11 and 14 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Narita* in view of arguments made by the Examiner; 3) rejected claims 15, 16, 19 and 20 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Narita* in view of Figure 1 of the instant application; 4) rejected claims 17, 18, 21 and 22 under 35 U.S.C. § 103(a) as allegedly unpatentable over *Narita* in view of Figure 1 of the instant application and further in view of *Inoue* (U.S. Pat. No. 6,748,547); 5) objected to Figure 2 as being directed to "prior art" yet not so marked; 6) objected to claims 15-22 because of a misspelling in independent claims 15 and 19; and 7) objected to the disclosure because there is purported confusion of references 140 and 142 with respect to Vout and Iout.

With this Response, Applicants have amended claims 1, 4, 5, 7, 8, 11, 12, 14, and 15, added new claims 23-27, and withdrawn claims 19-22. Therefore, claims 1-18 and 23-27 remain pending.

I. OBJECTIONS

A. Figure 2

The Examiner objected to Figure 2 as being directed to prior art and required a legend entitled "Prior Art" to be included in Figure 2 per M.P.E.P. § 608.02(g) (rev. 2, May 2004). Accordingly, the Applicants have amended Figure 2 to comply with the requirements set forth in § 608.02(g).

B. Claims 15-22

The Examiner objected to independent claims 15 and 19, as well as their dependent claims, as containing a misspelling. The Applicants thank the Examiner for noticing this inadvertent clerical error. Accordingly, the Applicants

have amended pending claim 15¹ to change the word “concerts” on line 2, to the word “converts.”

C. Reference Numerals 140 and 142

As best as the Applicants can tell, the Examiner rejected the use of reference numerals 140 and 142 in Figure 5 because of seemingly inconsistent usage with respect to Vout and Iout, which are also referred to in Figure 5. After a thorough review of the disclosure, Figure 5, and the Office Action, the Applicants are unaware of any inconsistent usage. The Applicants invite the Examiner to either call the Applicant's representative or specifically refer to the purported inconsistency in subsequent communications.

II. REJECTION OF CLAIMS 19-22

The Applicants have withdrawn claims 19-22 in order to narrow the issues before the Examiner and expedite prosecution. The withdrawal of claims 19-22 should not be construed as an admission by the Applicants as to the correctness of the Examiner's contention. Furthermore, the Applicants reserve the right to reassert the withdrawn claims later in prosecution of the instant application, or perhaps, in a continuation application.

III. REJECTION OF INDEPENDENT CLAIMS 1, 5, 8, 12, AND 15

Independent claims 1, 5, 8, 12, and 15 stand rejected under § 102(b) as allegedly anticipated by *Narita*. The Applicants respectfully traverse because *Narita* fails to teach or suggest every claim element. For example, claim 1, as amended, requires (emphasis added) that the “approximately constant power level is maintain at all times while said output current exceeds said threshold.” *Narita* does not teach any such arrangement. Instead, Figure 3 of *Narita* depicts a “threshold” current level at the point of intersection between region A (where the voltage is constant and the current varies) and region E (where the voltage is varied as the current varies). Above this “threshold” current level, however, region D, or alternatively region C, may be attained, where the voltage decreases as the current is maintained at the same value. Since the power level is a

¹ Claims 19-22 are withdrawn from prosecution with this Response.

product of the current and the voltage, the power level in regions D and C is not maintained at a constant level while still exceeding the threshold. See e.g., Col. 9., ll. 12-22. Therefore, not only does *Narita* fail to anticipate because it does not teach every element of claim 1, *Narita* also teaches against maintaining a constant power level at all times when the output current exceeds the threshold, and therefore cannot be properly used to render claim 1 or its dependent claims obvious.

Independent claims 5, 8, 12, and 15 contain limitations akin to those discussed above with regard to claim 1. Accordingly, independent claims 5, 8, 12, and 15, as well as their dependent claims, are not anticipated or rendered obvious by *Narita*.

IV. REJECTION OF INDEPENDENT CLAIMS 4, 7, 11, AND 14

Independent claims 4, 7, 11, and 14² stand rejected under § 103 as allegedly obvious by *Narita* in view of arguments made by the Examiner. More specifically, the Examiner contends that changes may be made to *Narita* to effectuate the "response speed" requirements of claims 4, 7, 11, and 14. The Applicants respectfully traverse these rejections for at least two reasons. First, the Examiner has failed to establish a *prima facie* case of obviousness. Second, the Examiner is relying on seemingly specious logical arguments without providing evidentiary support.

A. *Prima Facie* Case of Obviousness

As the Examiner is undoubtedly aware, a *prima facie* case of obviousness is established only if there is some suggestion or motivation to make the proposed changes to *Narita*. In fact, § 2143.01 of the M.P.E.P. (rev. 2, May 2004), as well as much of the case law upon which § 2143.01 is founded, states that just because a reference can be modified is not sufficient to establish a *prima facie* case of obviousness "unless the prior art also suggests the desirability of the

² In order to focus on the merits of claims 4, 7, 11, and 14, the Applicants have rewritten claims 4, 7, 11, and 14, in independent form. Rewriting these claims in independent form should not be construed as a narrowing amendment because these amendments are not made to distinguish over the cited art.

combination" (emphasis added). Additionally, this suggestion must come from the cited art and not from the Applicant's disclosure. M.P.E.P. § 2143. Although the Examiner provides several logical arguments as to the ability to change *Narita*, the Examiner does not provide any suggestion as to the desirability of making the proposed changes to *Narita*. Thus, the Examiner has failed to establish a *prima facie* case of obviousness for at least this reason.

B. Evidentiary Support for Logical Arguments

In rejecting claims 4, 7, 11, and 14, the Examiner sets forth a series of logical contentions as to why the recited "response speed" of the rejected claims are a matter of design choice. In so doing, the Examiner refers to amplifiers 120 and 140 as being responsive to voltage and current changes respectively and that a purported change in parts would dictate the response speed of each circuit. A close examination of Figure 1 of *Narita*, however, reveals that amplifiers 120 and 140 are contained within the feedback circuit section 400 and therefore even if amplifiers 120 and 140 are modified, at most, they would only impact the speed of the feedback circuit section 400. Thus, it is unclear how changing the current response of amplifier 120 and/or voltage response of amplifier 140 will do more than affect the voltage response of the voltage feedback circuit recited in the rejected claims and not affect the power control circuit in the rejected claims. Furthermore, the Examiner's logical contentions with respect to Figure 3, which also make reference to feedback selection circuit 400, are similarly specious.

Although, § 2144.03 of the M.P.E.P. allows the Examiner, in certain limited situations, to rely on logic as rationale in support of a § 103 rejection, if the Examiner relies on logic in making rejections, the Examiner must provide sound technical reasoning to support his or her conclusion. Furthermore, § 2144.03 also affords the Applicants the opportunity to challenge the Examiner's logical assertion in the next Office action. For at least the reasons set forth above, the Applicants respectfully submit that the Examiner's logical arguments are too tenuous and respectfully request that the Examiner support the logical contention with an affidavit of sound technical reasoning.

V. CONCLUSION

In the course of the foregoing discussions, the Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

The Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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**Appl. No. 10/034,718
Amdt. dated November 17, 2004
Reply to Office action of September 8, 2004**

Amendments to the Drawings:

The attached sheet of drawings includes changes to Figure 2. This sheet, which includes Figures 1-4, replaces the original sheet, including Figures 1-4. In Figure 2, the legend "Prior Art" has been added.

Attachment: Replacement Sheet

Annotated Sheet Showing Changes

Appl. No. 10/034,718
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 Annotated Sheet Showing Changes

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